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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,526	07/18/2003	Akio Yamamoto	0229-0765P	1175
2292	7590	10/04/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/621,526	YAMAMOTO, AKIO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alvin A. Hunter	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 7,9 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). **Misnumbered claims 10 (second occurrence) through 15 have been renumbered to 11 through 16.**

### ***Election/Restrictions***

Applicant's election without traverse of Species II, claim 8, in the reply filed on May 6, 2005 is acknowledged.

Claims 7, 9, and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 6, 2005.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the front portion having a rear edge convexly curved toward the club face, as set forth in claim 8, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

Claims 8 and 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, and 10-15 lack antecedent basis for the term "front portion". For purpose of examination, "front portion" will be interpreted as --front part--.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

1. Claims 1-6, and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (USPN 6406378) in view of Anderson et al. (USPN 5255918) and Helmstetter et al. (USPN 6325728) further in view of Hasebe et al. (USPN 6340337) and Sanpei et al. (JP 11-155982).

In regards to claim 1-6, Murphy et al. discloses a golf club head having a head volume in a range of from 175 to 400 cc and comprising a hollow body comprising a face portion 26 and a sole portion 42, wherein the sole portion is made of metal, and wherein the hollow body has a structure producing a ball-hitting sound whose sound pressure occurs around 6300 Hz, or 6.3 kHz (See Column 4, lines 60 and 61; Column 5, lines 57 through 60; and Column 9, lines 10 through 15; and Figure 5). Murphy does not disclose the face portion made of metal. Anderson et al. discloses a club head having a face portion 21 made of metal (See Background of the Invention and Summary of the Invention). One having ordinary skill in the art would have found it obvious to have the face portion of Murphy et al. made of a metal, as taught by Anderson et al., in order to increase the strength and durability of the club head. Helmstetter et al. discloses a sole plate for large volume club heads wherein the sole plate has a surface area of 7 sq. in. to 11 sq. in., or 4516 sq. mm to 7097 sq. mm. (See Column 4, lines 58 through 61). The sole of Helmstetter et al. is designed to optimize the moment of inertia of the club head (See Abstract and Summary of the Invention). One having ordinary skill in the art would have found it obvious to have the sole surface area of Helmstetter et al. incorporated into Murphy et al. in order to optimize the moment of inertia. Murphy

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et al. in view of Anders on et al. and Helmstetter et al. do not disclose the sole having a front part thicker than the back part wherein the front part has a substantially constant thickness. Hasebe et al. discloses a club head having a sole wherein the sole has a front part that is thicker than the back part and wherein the front part has a substantially constant and straight thickness (See Figures 7-9). Though Hasebe et al. does not teach the front part having a thickness from 1.2 to 1.8mm, the applicant does not set forth why the dimensions are critical in order to attain the invention. Hasebe et al. also notes that the front part is two times thicker than the back part, in which the relationship meets the requirements set forth by the applicant. One having ordinary skill in the art would have found it obvious to have the thickness of the front and back part of any value so long as it meets the relationship set forth by Hasebe et al. and improves the moment of inertia. Also, Sanpei et al. discloses a club head having a sole 2 comprising a thicker front part and a back pad next to the front part 7 wherein the thickness of the front part is 1.5mm and the thickness of the back part 7 is 1mm and the ratio of the average thickness of the back part to the average thickness of the front pad is less than 1 (See Figure 1 and Paragraph 0004). One having ordinary skill in the art would have found it obvious to have the sole of Murphy et al. in view of Anderson et al. and Helmstetter et al. to have a thicker front pad than the back pad, as taught by Sanpei et al., in order to increase the moment of inertia of the club head.

Regarding claims 10-14, Applicant does not set forth why it is essential for the front part's rear edge to be located in the middle of the sole portion. Page 6, last paragraph, set forth that the position of the front part's rear edge may be placed in

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various positions. Hasebe et al. discloses the rear edge of the front part located at 1/3 of the sole's length (See Column 6, lines 22 through 41). One having ordinary skill in the art would have found that the sole of Hasebe et al. would be capable of performing the same function as that of the applicant; therefore, making the location of the rear edge an obvious matter of design choice.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 11 has been objected to under 37 CFR 1.75 as being a substantial duplicate of claim 10. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Allowable Subject Matter***

Claim 8 is objected to as being dependent upon a rejected base claim, but may be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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